

be obvious to combine the mounting apparatus in Nissan with the engine described in Yasuyuki. See, Office Action at page 2.

However, Nissan and Yasuyuki fail to support a *prima facie* case of obviousness because there is insufficient motivation to combine the references. Regarding the motivation to combine the references, the Office Action states only that "[i]t would have been obvious to one of ordinary skill in the art to mount the engine of JP'051 in the manner taught by JP'122 since none other is taught, even in a FWD vehicle." This is improper. It is well settled that the mere fact that references can be combined is not sufficient to establish *prima facie* obviousness, unless the prior art suggest the desirability of the combination. See, MPEP § 2143.01(III).

There is no suggestion in either prior art reference to mount a variable compression ratio engine in the manner recited in the pending claims. Nissan relates to a non-variable compression ratio engine, and accordingly does not contemplate the need for a more specific mounting structure (for example, a need arising out of forces associated with changing the compression ratio or energy requirements associated with changing the compression ratio). Additionally, Yasuyuki is silent with respect to the need for a specific mounting structure. The absence of mounting structure is not sufficient motivation to combine the references, without at least some indication of the desirability of doing so.

In this regard, because the claims are directed to a mount apparatus for a variable compression ratio engine where the cylinder block and crankcase are moved relative to an axial direction of a cylinder, and where the engine has a mount portion provided on the crankcase, the compression ratio is varied by moving the cylinder block which is comparatively light-weight. Thus, the subject matter of the claimed invention is advantageous because it minimizes energy requirements used in varying the compression ratio. These features and advantages are not disclosed or suggested by the cited references,

and accordingly, the claims should be allowed. As stated in MPEP §2143.01(I), to support a *prima facie* case of obviousness, "the prior art must suggest the desirability of the claimed invention."

Claims 5-9 depend from claim 1 and therefore are patentable over the applied references for at least the reasons enumerated above, as well as for the additional features they recite.

In view of at least the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Aaron L. Webb
Registration No. 56,930

JAO:ALW/sqb

Date: June 27, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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